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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,688	01/10/2002	Mark Oscar Worthington	BTI2 00102203(USP2)P5X1	9661
7590	02/10/2005		EXAMINER	HUBER, PAUL W
DONALD BOLLELLA, LEGAL DEPARTMENT BURSTEIN TECHNOLOGIES, INC 163 TECHNOLOGY DRIVE IRVINE, CA 92618			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/043,688	WORTHINGTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul Huber	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-133 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-133 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____ .

**DETAILED ACTION*****Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-27, 53, 54 and 92-95, drawn to an optical disc system, a method, and a signal generated by a process, classified in class 369, subclass 47.1.
- II. Claims 28-38, 70-91, 96-118, 132 and 133, drawn to an assay method, a signal characteristic of information, a method of detecting a signal, and a method of imaging an investigational feature, classified in class 369, subclass 53.22.
- III. Claims 39-52, drawn to a method, classified in class 369, subclass 44.41.
- IV. Claims 55-69, drawn to a method, classified in class 369, subclass 124.12.
- V. Claims 119-124, drawn to a kit for the detection of an investigational feature in a test sample, classified in class 369, subclass 30.38.
- VI. Claims 125-131, drawn to an optical analysis disc, classified in class 369, subclass 275.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being utilized in a device which does not require depositing a test sample at a predetermined location on an optical disc assembly in order to acquire information about an investigational feature associated with the test sample, as required by invention II. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being utilized in a device which does not require obtaining information used to operate an optical disc drive from the tracking error signal, as required by invention III. See MPEP § 806.05(d).

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being utilized in a device which does not require converting each of the at least one analog signal into a corresponding digitized signal, each digitized signal being substantially proportional to an intensity of the returned light detected by a corresponding one of the at least one photo detector elements, as required by invention IV. See MPEP § 806.05(d).

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Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being utilized in a device which does not require a kit comprising carrier means being compartmentalized to receive one or more optical discs, as required by invention V. See MPEP § 806.05(d).

Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being utilized in a device which does not require that the optical disc includes either: a signal element and an operational layer having optical or magnetic characteristics selected to provide a predetermined contrast there between; or an investigational feature positioned relative to an operational layer, the investigational feature selected to be larger in size than a corresponding operational feature and at least as large in size as one-half of the track pitch, as required by invention VI. See MPEP § 806.05(d).

Inventions II and III-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions III-VI has separate utility such as being utilized in a device which does not require depositing a test sample at a predetermined location on an optical disc assembly in order to acquire information about an investigational feature associated with the test sample, as required by invention II. See MPEP § 806.05(d).

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as being utilized in device which does not require obtaining information used to operate an optical disc drive from the tracking error signal, as required by invention III. See MPEP § 806.05(d).

Inventions III and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of invention III can be practiced by another materially different apparatus than that of invention V, such as an apparatus which does not require a kit comprising carrier means being compartmentalized to receive one or more optical discs, as required by the apparatus of invention V.

Inventions III and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of

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using that product (MPEP § 806.05(h)). In the instant case the process of invention III for using the product of invention VI can be practiced with another materially different product, such as a product which does not require that the optical disc includes either: a signal element and an operational layer having optical or magnetic characteristics selected to provide a predetermined contrast there between; or an investigational feature positioned relative to an operational layer, the investigational feature selected to be larger in size than a corresponding operational feature and at least as large in size as one-half of the track pitch, as required by invention VI.

Inventions IV and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of invention IV can be practiced by another materially different apparatus than that of invention V, such as an apparatus which does not require a kit comprising carrier means being compartmentalized to receive one or more optical discs, as required by the apparatus of invention V.

Inventions IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of invention IV for using the product of invention VI can be practiced with another materially different product, such as a product which does not require that the optical disc includes either: a signal element and an operational layer having optical or magnetic characteristics selected to provide a predetermined contrast there between; or an investigational feature positioned relative to an operational layer, the investigational feature selected to be larger in size than a corresponding operational feature and at least as large in size as one-half of the track pitch, as required by invention VI.

Inventions V and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of invention V does not require that the optical disc includes either: a signal element and an operational layer having optical or magnetic characteristics selected to provide a predetermined contrast there between; or an investigational feature positioned relative to an operational layer, the investigational feature selected to be larger in size than a corresponding operational feature and at least as large in size as one-half of the track pitch, as required by the subcombination of invention VI. The subcombination has separate utility such as

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being utilized in a device which does not require a kit comprising carrier means being compartmentalized to receive one or more optical discs, as required by the combination of invention V.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was not made to the applicants' representative to request an oral election to the above restriction requirement due to the relative complexity of the restriction requirement and the need for the examiner to promptly act on the application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Huber whose telephone number is 703-308-1549.



Paul Huber  
Primary Examiner  
Art Unit 2653

pwh  
February 8, 2005